

REMARKS

Claims 1-118 were pending in the non-final Office Action mailed April 2, 2009. Claims 84-118 were withdrawn from consideration. Claims 25 and 59 are being cancelled. Claims 1-24, 26-58, and 60-83 are being amended. Support for claim amendments and the new claims can be found in the specification, at least in paragraphs[0024] – [0069]. Reconsideration of the action and further consideration are respectfully requested.

Objections

Claims 45-47, 49, 57, 70, 72, and 81 are objected to for minor informalities. These claims have been amended to correct the noted informalities.

§ 112 Rejections

Claims 6-7, 25, 38-39, 34-64, and 59 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In order to expedite prosecution, claims 25 and 59 are being cancelled, and claims 6, 34, and 38 have been amended to correct the noted deficiencies. Applicant respectfully requests the Examiner to withdraw the § 112 rejections.

§ 101 Rejections

Claims 1-64 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. While Applicant does not necessarily agree that the rejection is correct and reserves the right to re-present the claims in a continuing application, in order to expedite prosecution, independent claims 1 and 34 have been amended. Therefore, the Applicant respectfully requests the § 101 rejections to be withdrawn.

§ 102 Rejections

Claims 1-12, 25, 26, 28, 34-43, 56, 58, 60, 65-70, 71, 73-74, 76-80, and 82-83 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication No. 2003/0146939 (“Petropoulos”). Claims 33, 64, and 75 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos. Claims 27, 57, 72, 81 were rejected as allegedly

being unpatentable over Petropoulos as applied to claims 26, 56, 71, or 76 in view of U.S. Publication No. 2003/0224340 ("Housman"). Claims 13-24, and 44-55 were rejected as allegedly being unpatentable over Petropoulos as applied to claims 1 or 34 above, and further in view of U.S. Patent No. 7,035,812 ("Meisel"). Claims 29-32, 61-63 were rejected as allegedly being unpatentable over Petropoulos in view of Meisel and further in view of U.S. Publication No. 2003/0135460 ("Telegon"). Applicant respectfully traverses the rejections.

Claim 1 recites "delivering at one time, from a server to an end user device, at least one morphing advertisement in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement **including a first instance being a compact display format, a second instance being an expanded display format, and instructions** to enable the end user system to **initially display** the morphing advertisement in the **compact display format** and to **transition** the morphing advertisement **from the compact display format into the expanded display format** upon a user request to display the expanded display format **while no longer displaying the compact display format**."

Applicant respectfully asserts that the relied upon portions of Petropoulos fail to teach or suggest Applicant's claimed morphing advertisement. The search results page displayed in the Petropoulos system is not a teaching or suggestion of "delivering, from a server to an end user device, at least one morphing advertisement **including a first instance being a compact display format, a second instance being an expanded display format, and instructions.**" The relied upon portions of Petropoulos do not teach or suggest that the search result page that is delivered includes a first and second instance of a single advertisement as well as instructions.

Petropoulos describes allowing a user to see both a search result and a preview of the underlying information described by the search result (i.e., a preview of the webpage linked to by the result). The relied upon portions indicate that a search result is delivered then a preview can be prompted. Even if this is construed as being Applicant's claimed two instances, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two instances of an advertisement as well as the instructions are delivered as part of one advertisement. Rather, the relied upon portions of Petropoulos describe that "*upon a pre-defined placement or action of the pointer*" on a search result, "instructions are sent to the user's web browser to automatically open an embedded preview window and render the relevant contextual

information inline with the user's results." See paragraph [0023]. Therefore, as describe in the relied upon portions of the reference, the two different elements and instructions are delivered sequentially at three different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result instructions are delivered, and then the preview information is delivered). For at least this reason alone, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed delivery of two instances of an advertisement and the instructions together included in **one advertisement**.

The relied upon portions of Petropoulos do not teach or suggest that the search result page that is delivered includes **both** a first and second instance of a single advertisement. At most, the relied upon portion of Petropoulos describes that the preview information associated with the search result can include an advertisement but does not teach or suggest that the preview includes **two instances** of the same advertisement.

Further, the search results displayed in Petropoulos and the corresponding preview information is not a teaching of Applicants claimed **transitioning** of "the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format **while no longer displaying the compact display format**." As discussed above the relied upon portions indicate that a search result is delivered then a preview can be prompted. Even if this is construed as being Applicant's claimed two instances, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two instances of an advertisement **are transitioned** as set forth in Applicant's claim. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is delivered). Applicant respectfully asserts that there is *no transition* between the two instances as alleged by the Examiner. For this additional reason, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed transitioning of two instances of an advertisement as set forth in Applicant's claim

Finally, the search results displayed and the corresponding preview information displayed is not a teaching of displaying the "expanded display format **while no longer displaying the**

compact display format." Petropoulos displays the search results and the preview window is displayed "**inline with**" the search results. See [0023] and [0042]. Therefore, the search results are present *as well as* the preview window in the Petropoulos system. Applicant respectfully asserts that since Petropoulos displays both the search results *and* the preview information, the relied upon portions of Petropoulos do not teach displaying the expanded display format "**while no longer displaying**" the compact display format.

The relied upon portions of Housman, Meisel, and Telegon also do not teach or suggest the claimed subject matter missing from Petropoulos namely "delivering, from a server to an end user device, at least one morphing advertisement in response to the request to be presented on a webpage associated with a publisher, the morphing advertisement including a first instance being a compact display format, a second instance being an expanded display format, and instructions to enable an the end user system to initially display the morphing advertisement in the compact display format and to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format while no longer displaying the compact display format." Accordingly, the relied upon portions of Petropoulos, Housman, Meisel, and Telegon taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 102(e). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons. Claims 2-24 and 26-33 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 34 is directed to an apparatus comprising a server performing operations comprising delivering at one time at least one morphing advertisement in response to the request to be presented on a webpage associated with publisher, the morphing advertisement including a first instance being a compact display format, a second instance being an expanded display format and instructions to initially display the morphing advertisement in the compact display format and to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format while no longer displaying the compact display format. Claim 34 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 35-58 and 60-64 depend from claim 34 and are allowable for at least the same reasons set forth above with respect to claim 34.

Claim 65 is directed to a method comprising receiving an electronic document at an end user system, the electronic document including one or more morphing advertisements, the morphing advertisement including a first instance being a compact display format, a second instance being an expanded display format, and instructions for enabling the end user system to display both formats; displaying the compact display format of the morphing advertisement in the electronic document at the end user system; receiving a user request to display the expanded display format; transitioning the morphing advertisement from the compact display format into the expanded display format in the electronic document and no longer displaying the compact display format. Claim 65 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 66-75 depend from claim 65 and are allowable for at least the same reasons set forth above with respect to claim 65.

Claim 76 is directed to a method comprising receiving the electronic document, the electronic document including one or more morphing advertisements, the morphing advertisement including a first instance being a compact display format, a second instance being an expanded display format, and instructions for enabling an end user system to display both formats; displaying the compact display format of the morphing advertisement and content in the electronic document; receiving a user request to display the expanded display format; and transitioning the morphing advertisement from the compact display format into the expanded display format in the electronic document and no longer displaying the compact display format. Claim 76 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 77-83 depend from claim 76 and are allowable for at least the same reasons set forth above with respect to claim 76.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be

Applicant : Koningstein
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Filed : December 31, 2003
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understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

Please apply any charges not otherwise paid or any credits to deposit account 06 1050.

Respectfully submitted,

Date: May 21, 2009

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